

REMARKS-General

The newly drafted independent claim 33 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 33-44 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Regarding the drawings rejection raised by the examiner, the applicant would like to point out that Fig. 2 shows that element 211 has *phantom lines* drawn on it, which indicates that element 211 **can be solid or hollow**.

With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Regarding to the Qualification of the Abtahi (US 5,890,794) patent as Prior Art under 35USC102

Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the *invention* was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her *invention was patent* in this country more than one year prior to the date of the application for patent in the United States.

However, the Abtahi patent and the instant invention are *not the same invention* according to the fact that the disclosure of Abtahi patent does not read upon the instant invention and the independent claim 33 of the instant invention does not read upon the Abtahi patent too. Apparently, the instant invention, which discloses a light source arrangement, should not be the same invention as the Abtahi patent which discloses a lighting unit.

The applicant respectfully identifies the difference between the instant invention as claimed in the newly amended independent claim and Abtahi patent as follows:

(a) Regarding the newly amended independent claim 33, Abtahi patent discloses a light unit comprising a circuit board, a plurality of LED packages, a transparent cover a housing, a plurality of circuit wire, and a base. Abtahi is clearly silent as to the transparent light shelter having a *spherical shaped light projecting portion* projected from said peripheral surface of said supporting frame to align with said luminary elements. The feature allows convergence of light coming from the luminary units *without generating additional heat* so as to provide an enhanced light performance of the light source arrangement as a whole for a given number of luminary elements. The transparent cover disclosed in Abtahi patent does not have any spherical shaped light projecting portion.

(b) Also regarding the newly amended independent claim 33, the applicant would like to point out that the instant invention does not have "insulating housing 42" as disclosed in the Abtahi patent. According to Abtahi patent, "the insulating housing 42 includes a number of slots 44, into which leads 28 from LED packages 18 extend when the circuit board assembly 10 is assembled onto the housing..." (Abtahi, Col. 5, Lines 24-27) The instant invention is *silent* as to this important feature of Abtahi patent.

(c) Regarding the newly amended claim 34, which corresponds to the originally filed claim 19, the applicant would like to point out that element 110 is referred to as visibly transparent fluid (Abtahi, Col 7, Line 6), but *not* the "guiding window" as mentioned in the Office Action (Para. 7). Moreover, the applicant would like to submit that the instant invention is silent as to any "visibly transparent fluid", which according to Abtahi, is for cooling of LED packages (Abtahi, Col. 7, Lines 57-60). The instant invention does not utilize any fluid for lowering temperature of the luminary elements.

(d) Regarding the newly amended claims 35-36, Abtahi is silent as the luminary element haveing two terminal electrodes electrically coupling with a peripheral surface of the supporting frame and electrically connecting to the circuit respectively *in addition to* what is claimed in the newly amended independent claim 33.

(e) Regarding the newly amended claims 37-39, Abtahi is silent as the supporting frame being an elongated solid member solidly extending from the first end to another the dissipating end *in additional to* what is claimed in the newly amended independent claim 33.

(f) Regarding the newly amended claims 40-44, Abtahi is silent as the supporting frame having a polygonal cross section or a circular cross section *in additional to* what is claimed in the newly amended independent claim 33.

Response to Rejection of Claims 18, 20, 22-23, 25-26 and 28-32 under 35USC103

The Examiner rejected the originally filed claims 18, 20, 22-23, 25-26 and 28-32 over Abtahi. Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Abtahi which is qualified as prior art of the instant invention under 35USC102(b) are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In general, the examiner appears to reason that since Abtahi teaches that the light shelter, the guiding window, the terminal electrodes and the cross sectional shape

of the supporting frame, it would have been obvious to one skilled in the art to modify Abtahi in light of "general skill of a worker". But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

Indeed, the only mention of the various features as rejected under 35USC103 is in applicants own specification and claims. Accordingly, it appears that the Examiner has fallen victim to the insidious effect of a hindsight analysis syndrome where that which only the inventor taught is used against the teacher in W.L. Gore and Associates v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984).

Moreover, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. In re Lesilie, 192 USPQ 427 (CCPA 1977).

In hindsight, the Examiner may feel that it would be obvious to modify Abtahi in view of "general skill of worker". Such hindsight reconstruction is not a permissible

method of constructing a rejection under 35 U.S.C. 103. *In re Warner and Warner*, 154 USPQ 173, 178 (CCPA 1967).

“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness...” *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

The Office Action fails to provide a reasoned analysis on why one of ordinary skilled in the art would have modified embodiments in the detailed description of the preferred embodiment of the Abtahi patent.

In any event, the applicant would like to clarify the difference between the instant invention and Abtahi patent, with a view to overcome the 35USC103 rejections, as follows:

(g) Regarding the newly amended claim 33, the fact that Abtahi is silent as to the transparent light shelter having a *spherical shaped light projecting portion* projected from said peripheral surface of said supporting frame to align with said luminary elements indicates this feature of the instant invention is not suggested, motivated, or taught by the cited art. As mentioned earlier, the feature allows convergence of light coming from the luminary units *without generating additional heat* so as to provide an enhanced light performance of the light source arrangement as a whole for a given number of luminary elements. Moreover, Abtahi utilizes the “visably

transparent fluid 110" for cooling the LED packages, this feature is absent in the instant invention.

(h) Regarding the newly amended claims 33-34, Abtahi discloses a plurality of LED packages penetrating through an insulating housing (42) from the circuit board assembly (10). The instant invention *is silent* as to the insulating housing (42). Moreover, the instant invention is silent as to the visibly transparent fluid (110). The applicant respectfully argues that the instant invention resolves the conundrum of effectively insulating heat while allowing effective illumination from the luminary units.

(i) Regarding the newly amended claims 42-44, Abtahi does not specifically teach that the supporting frame has polygonal cross section. The applicant would like to submit that the subject matter contained in claims 42-44 is not obvious in view of Abtahi when they are considered in light of the newly amended independent claim 33 and any other dependent claims preceding claims 42-44.

Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 33-44 at an early date is solicited.

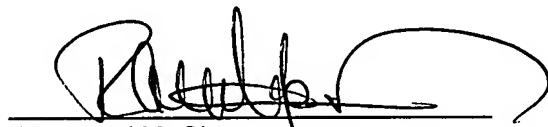
Should the examiner believes that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Cont.:

Atty's/ Docket No.: USDP2274A-ALL

Application No.: 10/684,191

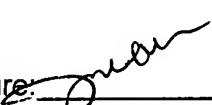
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